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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,014	09/17/2003	John M. Calico	034726/261916	9128
1342	7590	03/31/2005	EXAMINER PHAN, THIEM D	
PHILLIPS LYTTLE LLP INTELLECTUAL PROPERTY GROUP 3400 HSBC CENTER BUFFALO, NY 14203-3509			ART UNIT 3729	PAPER NUMBER

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/667,014

Applicant(s)

CALICO, JOHN M.

Examiner

Tim Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 and 28-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group III, Claims 17-30, filed on 2/18/05 is acknowledged.

The Restriction mailed on 2/16/05 has been carefully reviewed and is held to be proper. However further Restriction is necessary with respect to method Claims 17-30 because of an oversight on the part of the Examiner who initially restricted this Application.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

III-A. Claims 17-21 & 28-30, drawn to a method of forming a stator, classified in class 29, subclass 596.

III-B. Claims 23-27, drawn to a method of forming an electric motor, classified in class 29, subclass 607.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions III-A and III-B are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant

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case, the combination as claimed does not require the particulars of the subcombination as claimed because the method of forming a stator as recited in Group III-A does not require a rotor thereof, as required by Group III-B. The subcombination, Invention III-B, has separate utility such as making an electric motor.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group III-A is not required for Group III-B, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Peter K. Sommer (716-847-8400) on 3/24/05 to discuss the above restriction requirement, and did result in an election being made for Group III-B (Claims 23-27) while Group III-A (Claims 17-21 & 28-30) were withdrawn. Applicant is required to cancel these nonelected claims (16-22) or take other appropriate action.

Applicant is advised that the reply to this requirement to be complete must include an

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election of the invention to be examined even though the requirement be traversed (37 CFR 1.143) later on.

An Office Action on the merits of Claims 23-27 now follows.

*Title*

6. The following title is suggested: "A Method Of Forming an Electric Motor".

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 23 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al (US 5,592,731) hereinafter '731.

**As applied to claim 23**, the '731 teaches a method of constructing a stator, comprising:

- compacting or pressing (Col. 5, lines 20-22) one or more powdered metallic materials to form a stator having at least two stator segments (Fig. 4a, 20), each stator segment having

one or more teeth that form a substantially toroidal or circular path for magnetic flux entering or exiting the stator segment and each stator segment having a respective continuous insulated electric winding by lap winding (Col. 7, lines 58-62) for forming a magnetic field within the stator segment when said winding is electrically energized; and

- placing or accommodating an inside rotor (Abstract) capable of producing a second magnetic field and having at least two magnetic poles (Col. 2, lines 12-15) in a cooperative relationship with the stator such that magnetic poles of the rotor interact with the magnetic field within the stator element.

**As applied to claim 27**, the '731 teaches that the rotor has magnetic poles created by permanent magnets (Col. 2, lines 12-14).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '731.

As applied to claims 24- 26, the '752 teaches a method of constructing a stator, which reads on Applicant's claimed invention, including the compaction of metallic powder into stator segments by a die (col. 5, lines 19- 22), except for applying the dynamic magnetic compaction (DMC) process with embedded wirings, which is well known in the art (Applicant's Related Art, page 2, lines 9, 17-22).

It would be obvious to one of ordinary skill in the art at the time the invention was made to apply the dynamic magnetic compaction (DMC) process with embedded wirings in order to form a variety of components' shapes for the stator or rotor segments and reduce production time.

### ***Conclusion***

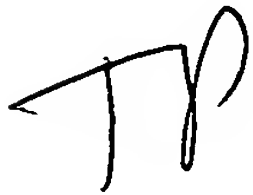
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M - F, 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tim Phan  
Examiner  
Art Unit 3729

tp  
March 28, 2005

  
**CARL J. ARBES**  
**PRIMARY EXAMINER**